Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: MCCOY

Application Serial No.: 09/731,008

Filing Date: December 7, 2000

For: METHOD AND PRODUCT FOR CALCULATING A NET OPERATING INCOME AUDIT AND FOR ENABLING SUBSTANTIALLY IDENTICAL AUDIT PRACTICES AMONG A PLURALITY OF AUDIT FIRMS

Confirmation No.: 8773

Group Art Unit: 3627

Examiner: Andrew J. Rudy

REASON(S) FOR REQUESTING A PRE-APPEAL BRIEF REVIEW

Attorney Docket No.: G04.004 (formerly G03.020)

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I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on May 9, 2007

By: Edith Martin

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated January 9, 2007, Applicant respectfully requests a Pre-Appeal Brief Review for the reason(s) that begin on page 2 of this paper.

REASON(S) FOR REQUESTING A PRE-APPEAL BRIEF REVIEW

Claims 1 - 18 are in the application. Claims 1 – 6 are currently being prosecuted and claims 7 – 18 have been withdrawn. Claims 1 and 6 are the independent claim herein.

Claim rejections under 35 USC 112, 2nd paragraph

Claims 1 – 6 stand finally rejected under 35 USC 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant claims as the invention.

Regarding claim 1, the Office Action rejected the use of the term "similar" in claim 1, line 20. The Office Action further states that the descriptive portion of the Specification does not appear to validate the particular use of the word "similar".

In reply thereto, Applicant notes that support for the use of the particular wording recited in claim 1 is found in the Specification at paragraph [0039].

Independent claim 6 does not include the term "similar". Thus, Applicant views the rejection thereof under 35 USC 112, 2nd paragraph in the Office Action as an error on the part of the Office.

Accordingly, Applicant respectfully submits that the proposed amendment to claim 1 fully addresses and overcomes the rejection under 35 USC 112, 2nd paragraph. Further, Applicant respectfully submits that the rejection of claim 6 is moot per the rejection under 35 USC 112, 2nd paragraph. Therefore, reconsideration and withdrawal of the rejection of claims 1 – 6 under 35 USC 112, 2nd paragraph are respectfully requested.

Claim Rejections Under 35 USC § 103(a)

Claims 1 - 6 stand finally rejected as being unpatentable over van Zee et al., U.S. Patent No. 7,058,685 (hereinafter, van Zee), in view of Donner, U.S. Patent No. 6,154,725. This rejection is respectfully traversed.

Applicant respectfully submits that the cited and relied upon van Zee and Donner fail, as a matter of fact, to disclose or suggest at least one aspect recited in each of the pending claims 1 - 6. Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the final rejection.

Applicant's independent claim 1 relates to a method for calculating a net operating income audit (NOI) and enabling substantially identical audit practices among a plurality of audit firms. See Applicant's Response to January 9, 2007 Final Office Action, page 7, paragraph 6 – page 8, paragraphs 4 and 5.

The Final Office Action cited and relied upon van Zee for disclosing deploying a computer program to plurality of parties, and Donner for disclosing a computer-implemented audit system estimating a value of an intellectual property portfolio. The Final Office Action further stated that to have deployed a computer program to a plurality of parties to include a computer-implemented audit system estimating a value of an intellectual property portfolio for van Zee would have been obvious to one of ordinary skill in the art in view of Donner. The Final Office admitted that neither van Zee [n]or Donner discloses conducting an audit of real estate property and generating as associated value of net operating income.

However, the Final Office Action took Official Notice "that conducting an audit of intellectual property, e.g., real estate, and generating an associated value of net operating income has been common knowledge in the real estate audit art."

Applicant respectfully submits that the Examiner's rejection of claims 1 – 6 on the basis of the Official Notice that an intellectual property audit is an example of a "real estate" audit is, factually, erroneous.

As stated in Applicant's AF Amendment and Response to the January 9, 2007 Final Office Action, intellectual property is not, as a matter of fact, the same as, an example of, or suggestive of real property or real estate. Applicant reiterates that the differences between the attributes and characteristics of real property and intellectual property, including the corresponding differences associated with the audits of each, are

so great as to render the Examiner's rejection fatal as a matter of fact. (See Applicant's AF Amendment and Response to the January 9, 2007 Final Office Action, page 10, 2 – 4)

Accordingly, the Official Notice taken and relied upon by the Examiner is factually flawed and clearly erroneous.

Regarding the cited and relied upon van Zee, Applicant notes that van Zee relates to a method and digital content delivery service system for sending and validating/auditing delivery of e-media. In particular, e-media is disclosed as being "electronic data files, including digital pictures and the like" (van Zee, col. 1, ln. 16 -17). The disclosed e-media is not disclosed or suggested as being the same as Applicant's claimed "computer program" nor is the e-media disclosed or suggested as being the same as Applicant's claimed "said computer program operating to receive a first input data". In fact, the operation of any e-media does not appear to be discussed or considered in van Zee since van Zee is concerned with the delivery of e-media and the audit and verification of that delivery. For example, see van Zee, col. 2, ln. 16 – 18; and col. 5, ln. 14 – 16.

Thus, it is factually clear that van Zee does not disclose deploying a computer program to a plurality of parties wherein the computer program operates to receive a first input data.

Applicant reiterates that the "audit" disclosed in van Zee refers to a record concerning the delivery of e-media. Van Zee's audit is not the same as Applicant's claimed "NOI audit report" associated with real estate properties. For example, a record of the stages of delivery for e-media content is not the same as or suggestive of Applicant's claimed NOI audit report. The delivery of the e-media in van Zee is not, in any manner, associated with or related to a net operating income. (See Applicant's AF Amendment and Response to January 9, 2007 Final Office Action, page 9, paragraph 6)

Applicant also takes issue with the Examiner's characterization that the proposed claim amendments submitted in Applicant's AF Amendment and Response to the

January 9, 2007 Final Office Action raised new issues by materially altering the scope of the claims. Applicant respectfully submits that claim 1 was amended by adding the word "and" to correct a grammatical informality. Thus, the claim scope due thereto was unchanged. The only other amendment, changing "developed similar audit practices" to "developed by substantially similar audit practices" was also done primarily to correct a grammatical error (adding "by"). Regarding the "substantially", Applicant notes that the title and Specification of the Application includes the phrase "substantially identical audit practices". Thus, the scope of claim 1 was also not materially altered by this change.

Therefore, Applicant respectfully submits that the cited and relied upon van Zee and Donner fail to disclose or suggest the claimed method. The combining of the references as cited and relied upon by the Examiner does not overcome or obviate the clear errors in the rejection.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that the cited and relied upon combination of van Zee and Donner does not render claims 1 - 6 obvious under 35 USC 103(a). The reconsideration and withdrawal of the rejection of claims 1 - 6 are requested.

Accordingly, Applicants respectfully request allowance of the pending claims.

Respectfully submitted,

March 9, 2007
Date

/RPC/

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): G04.004 (formerly G03.020)

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Application Number	Filed
09/731,008	12/07/2000

First Named Inventor: McCoy, Mary Kay

Art Unit	Examiner
3627	Rudy, Andrew J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____.
- [X] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 45,371

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May 9, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

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